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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,161	10/26/2001	Vincent James Gatto	EP-7531	8727
7990 05/28/2004				
Ethyl Corporation 330 South Fourth Street Richmond, VA 23219				
EXAMINER MCANVOY, ELLEN M				
ART UNIT		PAPER NUMBER		
1764				

DATE MAILED- 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)	
10/062,181	GATTO, VINCENT JAMES	
Examiner	Art Unit	
Ellen M McAvoy	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(s).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-13, 29-35 and 39-48 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 14-25, 27, 28, 36-38 and 49-61 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 7-9, 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date: ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4 Mar 2002; 25 Mar 2003</u>   | 6) <input type="checkbox"/> Other: ____                                     |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The identity of the R groups of the formula, R and R', must be set forth in the independent claim as they are in dependent claim 37.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Univ. Picardie (French Patent 2,735,130 A) and Len et al (the article "Synthesis and Antifungal Activity of Novel Bis(dithiocarbamate) Derivatives of Glyccerol).

Univ. Picardie discloses sulphur-containing carbanic polyesters. The compound set forth on page 23 meets the limitations of the chemical structure of claims 36-38.

Len et al discloses bis(dithiocarbamate) compounds represented by scheme 1 which also meets the limitations of the claims.

Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated by Kubota (Database accession no. 88:74354 (XP 002228723)).

The compound set forth on page 2, marker 45, anticipates the compound of claim 36.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6, 14-25, 27, 28, and 49-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latyuk et al (Database accession no. 137:127291 (XP002228722)) in combination with Smalheer et al.

Latyuk et al ["Latyuk"] discloses nitrogen derivatives of 1-alkylthio-3-R'-propanol-2 as set forth on pages 3-9 (markers 20-26) which meet the limitations of the compounds of claims 1, 2, 5 and 6. Latyuk teaches that the compounds may be used as additives in base oils where they display good antiwear, antiscuff and anti-corrosion properties. Applicants invention differs in some of the depending claims by adding conventional lubricant additives such as detergents, dispersants, and antioxidants to the oil composition comprising the nitrogen derivatives. Smalheer et al is added to show that such additives are known in the art including the specific antioxidant compounds of dependent claim 17. It has been well-established that the combination of known lubricant additives together in one lubricant composition for their known imparted

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properties is obvious. And, although specific oil compositions such as engine oils, railroad oils, natural gas engine oils, hydraulic oils, turbine oils, rust and oxidation oils, and automatic transmission fluids are not set forth in Latyuk, they may all be comprised of base lubricating oils which is clearly taught in the prior art.

#### ***Allowable Subject Matter***

Claims 3, 4, 7, 8, 9, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10-13, 29-35, and 39-48 are allowed over the prior art references of record.

#### ***Conclusion***

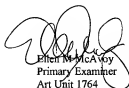
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
May 24, 2004